

REMARKS

Status of the Case

This application was filed on February 13, 2002 and relates to coffee compositions with stable flavor characteristics and methods of making the same. The present invention consists of a beverage composition comprising a coffee portion comprising a resulting coffee component, said coffee portion exhibiting a resulting coffee component profile, said coffee portion comprising (i) a coffee source comprising a coffee source component, said coffee source exhibiting a coffee source component profile; (ii) a coffee source component modifier; (iii) a supplemental coffee source component; wherein the amount of said resulting coffee component mimics the amount of a target coffee component in a component profile of a target coffee, and wherein said coffee portion has a pH value in the range of from about 2.0 units below to about 2.0 units above the pH value of a coffee element of said target coffee.

The Examiner's Action sets forth a restriction requirement of the foregoing beverage compositions and its application to roast and ground coffee, a soluble coffee product and a coffee extract. Applicants herein elect the roast and ground species pursuant to this restriction, and have amended the claims to reflect this election.

The Examiner's Restriction Requirement

In setting forth the restriction requirement, the Examiner indicates that the application is directed to three patentably distinct inventions. The Examiner cites to 35 U.S.C. § 121 which requires that Applicants elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. The Examiner indicates that Claims 1-5, 10-13 and 18-21 are generic. On this basis, the Examiner has required restriction to one of the following three Species:

- (A) Claims 6, 9, 14 and 17 drawn to roast and ground coffee;
- (B) Claims 7 and 15 drawn to a soluble coffee product; and
- (C) Claims 8 and 16 drawn to a coffee extract.

Applicants' Election and Traverse

Applicants hereby provisionally elect to prosecute the subject matter of Species A, which is drawn to a roast and ground coffee source, and respectfully request reconsideration of the restriction under 37 C.F.R. §1.143. Claims 1-6, 9-14 and 17-21 are believed to read on the elected subject matter.

Applicants respectfully traverse the restriction requirement and assert that the Examiner has failed to establish a *prima facie* case for restricting the claims. To establish a *prima facie* case for restriction, the Examiner must show that (1) the inventions are either (a) independent, or (b) distinct; and (2) there is a serious burden on the Examiner, as shown by (a) separate classification; (b) separate status in the art; or (c) a different field of search. Applicants respectfully assert that the Examiner's Action fails to satisfy the second criteria, and therefore, fails to establish a *prima facie* case of restriction.

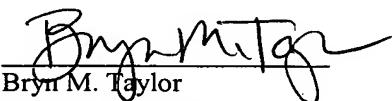
Specifically, Applicants respectfully assert that the Examiner fails to show that there is a serious burden in searching the three species collectively. The examiner has not provided any indication that the three species require either (a) separate classification; (b) separate status in the art; or (c) a different field of search. Without such an indication, Applicants respectfully submit that a *prima facie* case for restriction has not been established.

In view of the foregoing, Applicants assert that there is no evidence to support the Examiner's contention that the three species designated herein require restriction to allow further prosecution of this case. Therefore, because of this lack of support, the Examiner's Action fails to establish a *prima facie* case for restriction and Applicants respectfully traverse the restriction requirement.

Conclusion

For the foregoing reasons, Applicants provisionally elect Species A with traverse and respectfully request reconsideration of the restriction requirement under 37 C.F.R. § 1.143. Furthermore, it is requested that the Examiner withdraw the restriction requirement and allow Claims 1-21.

Respectfully submitted,

  
\_\_\_\_\_  
Bryn M. Taylor  
Attorney for Appellants  
Registration No. 55,668  
Telephone: (513) 634-2084

Date: May 19, 2004

Customer No. 27752